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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER
SMITH, RICHARD A

ART UNIT	PAPER NUMBER
2859	

DATE MAILED: 10/03/2002

#7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/987,709	MURRAY, JOHN C.	
	Examiner	Art Unit	
	R. Alexander Smith	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892) ✓
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

1. The specification is objected to because of the following informalities:

a. Page 1, lines 4-5 are objected to since the application is now U.S. 6,324,769.

b. Page 4, line 2: "few" should be --view--.

c. Page 12, lines 7-8: --is-- should be inserted before "too large to fit".

d. Page 19: there are numerous occurrences of two different elements, i.e., "blade" and "housing assembly" having the same drawing number "12".

e. Page 24, lines 27-29: two different elements, i.e., "holding member" and "hook member" have the same drawing number "34".

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 4,429,462 to Rutty et al. in view of U.S. 4,459,753 to Nagasawa et al.

Rutty et al. discloses a retractable rule assembly having the limitations in lines 1-17 of claim 1, and discloses the blade having a width and height of concavo-convex configuration.

Rutty et al. does not disclose the blade having a width in flattened configuration within the range of 1.1" - 1.5" and a height in the concavo-convex configuration within the range of 0.25" - 0.40".

Nagasawa et al. discloses a retractable rule assembly having a housing and a coilable blade, said blade being non-metal, having a width of greater than 1" (column 3, lines 13-18, i.e., up to 30mm, about 1.18") and having a concavo-convex curvature that can be varied between 1/3 and 3/4 of the circumference (L, see figure 1) in order to provide a stand-out greater than 1000mm (Table 1) and to allow the non-metal blade to coil flat into the housing. Nagasawa et al. also discloses that at the concavo-convex curvature of 3/4 of the circumference that the blade can have graduations applied to both sides (column 4, lines 1-8). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to make the elongated metal blade, taught by Rutty et al., wider than 1" and to have a high height, as suggested by Nagasawa et al., in order to improve the stand-out while still allowing the blade to retract into the housing.

With respect to the specific widths and heights, i.e., 1.1"-1.5" and 0.24"-0.40" respectively, as claimed by Applicant. These specific widths and heights would be obvious as being merely manufacturing choices based on the preferences of the user or manufacturer. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to use the specific widths and heights as claimed with the retractable rule assembly, taught by Rutty et al. and modified by Nagasawa et al., based on preferences of a user or manufacturer in order to obtain the desired stand-out while still allowing the blade to retract into the housing..

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is rejected under the judicially created doctrine of double patenting over claim 18 of U. S. Patent No. 6,324,769 since the claim, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. as

follows: The limitations of claim 1 are clearly disclosed in claim 18 of U. S. Patent No. 6,324,769.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Response to Arguments

6. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

With respect to Rutty et al. and the discussion of the advantages and tradeoffs discussed therein with respect to the width and depth of curvature, and the applicant's arguments with respect to the problems associated with the width and height: The applicant's arguments are not persuasive since it appears to the examiner that the advantages of these widths and heights versus the tradeoffs would be obvious as being merely manufacturing choices based on the preferences of manufacturer with respect to the advantages versus the tradeoffs. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to use the specific widths and heights as claimed with the retractable rule assembly, taught by Rutty et al., based on preferences of manufacturer of the advantages obtained in increasing the stand-out while accommodating the tradeoffs associated with retraction and longevity of the retractable rule assembly.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related retractable rule assembly.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Smith whose telephone number is (703) 305-0647. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

RAS
September 30, 2002